

**REMARKS**

Applicant concurrently files herewith an Excess Claim Fee Payment Letter for one(1) excess total claim.

Claims 1-14, 16-19 and 21-27 are all of the claims presently pending in the application. The claims have not been amended by the present Amendment. Claims 25-27 have been added to claim additional features of the invention. Claim 15 has been canceled without prejudice or disclaimer.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicant gratefully acknowledges the Examiner's indication that claims 10 and 11 would be allowable if rewritten in independent form. However, Applicant submits that all of the claims are allowable over the cited prior art references.

Claim 15 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 15 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-9, 12-14, 16-19 and 21-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, JP 11-112028 (hereinafter "JP '028"). Claim 8 stands rejected under 35 U.S.C. § 103(a) as obvious over JP '028 in view of Krausse, III (U.S. Patent No. 4,891,686; hereinafter "Krausse").

These rejections are respectfully traversed in the following discussion.

**I. THE CLAIMED INVENTION**

The claimed invention of exemplary claim 1, provides a light-emitting device including a semiconductor light-emitting element using a substrate surface as a main light-extracting surface (e.g., see Application at page 14, lines 12-16 and Figure 3). Accordingly, the heat-radiating characteristic is improved so that the durability of the light-emitting device is improved (see Application at page 5, lines 6-17). Additionally, this feature is important for improving the light-emitting efficiency of the light-emitting element (see Application at page 1, lines 19-22).

## II. 35 U.S.C. 112, FIRST PARAGRAPH, REJECTION

The Examiner has rejected claim 15 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner stated that the “plurality of swollen portions” is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention.

Merely in an effort to speed prosecution, claim 15 has been canceled, thus rendering the Examiner’s rejection moot.

## III. 35 U.S.C. 112, SECOND PARAGRAPH, REJECTION

The Examiner has rejected claim 15 under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Examiner alleged that the exact structure of the term “plurality” is vague and indefinite.

As indicated above, merely in an effort to speed prosecution, claim 15 has been canceled, thus rendering the Examiner’s rejection moot.

## IV. CLAIM REJECTIONS BASED ON PRIOR ART GROUNDS

### A. The JP ‘028 Reference

The Examiner alleges that JP ‘028 teaches the claimed invention of claims 1-9, 12-14, 16-19 and 21-24. Applicant submits, however, that there are features of the claimed invention, which are neither taught nor suggested by JP ‘028.

That is, JP ‘028 does not teach or suggest a light-emitting device including “*a semiconductor light-emitting element using a substrate surface as a main light-extracting surface*” (emphasis added) as recited in exemplary claim 1.

Indeed, the Examiner attempts to rely on Figure 5a of JP ‘028 to support his allegations. The Examiner, however, is clearly incorrect.

That is, the light-emitting element of JP ‘028 has a main light-emitting surface on the electrode surface side (see JP ‘028 at paragraphs [0029]-[0030]). Specifically, JP ‘028 recites, “the light which leaks and comes out of the crystal substrate 4a of a light emitting device 4 joins luminescence from the main light drawing side” (see JP ‘028 at second line of paragraph [0030]) (emphasis added). At this point, the main light drawing side is the p

lateral electrode 4b side (see JP '028 at paragraphs [0016] and [0021]).

As discussed in the specification of the Application, such a light-emitting element as disclosed in JP '028 has problems of difficulties in obtaining a high output from the light-emitting element and low light-extracting efficiency (see Application at page 3, line 18 through page 4, line 11).

In contrast, a light-emitting element of the claimed invention uses a substrate surface as a main light-extracting surface. Thus, Applicant submits that the claimed invention of amended claim 1 is not taught or suggested by JP '028.

In the Examiner's response to Applicant's arguments (e.g., see Office Action dated September 2, 2005 at page 5) the Examiner alleges that "any light emitting surface of '028 can be labeled as a "main" light emitting surface". The Examiner, however, is clearly incorrect.

Applicant submits that the light emitting surface in the claimed invention and JP '028 have not been arbitrarily labeled "main", as alleged by the Examiner. Indeed, JP '028 explicitly teaches that "[t]he light emitting device 4 which equipped the main light drawing side side with p lateral-electrode 4b and n lateral-electrode 4c" (e.g., see JP '028 at Abstract). JP '028 specifically teaches that the electrode side of the light-emitting device is the "main light drawing side".

In stark contrast, the claimed invention specifically recites that the substrate surface may be the main light-extracting surface (e.g., as defined in exemplary claim 1). The Application clearly states that light-emitting elements having a main light-emitting surface on an electrode surface side is structurally inferior in light-emitting output to a light-emitting element having a main light-emitting surface on the substrate surface side" (see Application at page 3, lines 18-23) (emphasis added). Therefore, Applicant submits that the recitation of a "main light-extracting surface" is clearly not arbitrary in view of the teachings of JP '028 and the claimed invention.

Therefore, in view of the foregoing, Applicant submits that JP '028 does not teach or suggest each and every feature of the claimed invention defined by independent claim 1. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **B. The Krausse Reference**

The Examiner alleges that Krausse would have been combined with JP '028 to form

the claimed invention of claim 8. Applicant submits, however, that, even if combined, the alleged combination of references would not teach or suggest each and every element of the claimed invention.

That is, neither JP '028 nor Krausse, nor any combination thereof, teaches or suggests a light-emitting device including "*a semiconductor light-emitting element using a substrate surface as a main light-extracting surface*", as recited in claim 1.

The Examiner attempts to rely on Krausse as teaching multiple bonding wires for lowering inductance. However, the Examiner does not point out any specific portion of Krausse to support his allegations.

That is, nowhere does Krausse teach or suggest a light-emitting device including a semiconductor light-emitting element using a substrate surface as a main light-extracting surface. Indeed, the Examiner does not even allege that Krausse teaches or suggest these features.

Thus, Krausse fails to make up for the deficiencies of JP '028.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

## V. NEW CLAIMS

New claims 25-27 have been added to provide more varied protection for the claimed invention and to claim additional features of the invention. These claims are independently patentable because of the novel features of the recited therein.

Applicant submits that new claims 25-27 are patentable over any combination of the applied references at least for analogous reasons to those set forth above with respect to claims 1-14, 16-19 and 21-24.

## VI. FORMAL MATTERS AND CONCLUSION

Applicant again respectfully requests acknowledgement and receipt of the priority document filed with the Application on September 17, 2003.

Regarding the Examiner's objection to the drawings, Applicant respectfully submits that claim 15 has been cancelled, thus rendering the Examiner's objection moot.

In view of the foregoing, Applicant submits that claims 1-14, 16-19 and 21-27, all of

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the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

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Respectfully Submitted,



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